

### **REMARKS/ARGUMENTS**

Claims 1 – 27 are presented for reconsideration and further examination in view of the following remarks.

In the outstanding Office Action, the Examiner rejected claims 1 – 12 and 14 – 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,499,626 to Julius (hereinafter referred to as “the Julius ‘626 patent”) in view of U.S. Patent No. 6,766,919 to Huang et al. (hereinafter referred to as “the Huang et al. ‘919 patent”); and rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over the Julius ‘626 patent in view of the Huang et al. ‘919 patent and further in view of U.S. Patent No. 6,394,298 to Zaidman (hereinafter referred to as “the Zaidman ‘298 patent”).

By this Response, Applicants respectfully traverse the Examiner’s rejections.

It is respectfully submitted that no new matter, within the meaning of 35 U.S.C. §132, has been introduced to this application.

#### **Claims 1 – 12 and 14 – 27**

The Examiner rejected under 35 U.S.C. §103(a) claims 1 – 12 and 14 – 27 as being unpatentable over the Julius ‘626 patent in view of the Huang et al. ‘919 patent.

#### **Response**

Referring to the Examiner’s rejections, Applicants traverse the Examiner’s rejections since the cited prior art combination does not disclose, teach or suggest all of the features of the presently claimed invention and since there is no motivation to combine the Julius ‘626 patent with the Huang et al. ‘919 patent.

To establish a *prima facie* case of obviousness, the Examiner must establish: some

suggestion or motivation to modify the references exists; and that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Independent claim 1 recites: “[a] dispenser for a tissue package, said dispenser comprising a tissue dispensing aperture and a manipulating opening, both opening into a tissue-containing space of the package; said tissue dispensing aperture is sized for dispensing one tissue at a time while separating a duty tissue from a successive tissue; wherein said manipulating opening is normally closed by a flap and is deformable to allow introduction of a user’s fingers into the tissue-containing space, and wherein said tissue dispensing aperture and the manipulating opening are coverable.”

Independent claim 25 recites: “[a] rigid cover engagable with a tissue box, said cover fitted with a dispenser comprising a tissue dispensing aperture and a manipulating opening, both opening into a tissue-containing space of the box; said tissue dispensing aperture is sized for dispensing one tissue at a time while separating a duty tissue from a successive tissue; wherein said manipulating opening is normally closed by a flap and is deformable to allow introduction of a user’s fingers into the tissue-containing space, and wherein said tissue dispensing aperture and the manipulating opening are covered by a lid.”

Independent claim 27 recites: “[a] tissue package comprising a dispenser fitted with a tissue dispensing aperture and a manipulating opening, both opening into a tissue-containing space of the package; said tissue dispensing aperture is sized for dispensing one tissue at a time while separating a duty tissue from a successive tissue; wherein said manipulating opening is normally closed by a flap and is deformable to allow introduction of a user’s fingers into the tissue-containing space, and wherein said tissue dispensing aperture and the manipulating opening are covered by a lid.”

In the Action, the Examiner cited the Julius ‘626 patent in combination with the Huang et al.

'919 patent as rendering the presently claimed invention obvious. The Julius '626 patent is directed toward correcting the drying problem associated with tissues impregnated with fluid, which is to remove the tissues from the dispensing opening and return the tissues to the tissue container. Also, the Julius '626 patent discusses the problems in enabling a tissue to stay in the pop-up configuration associated with large (manipulating) openings, which are directly connected to dispensing openings and may thus be considered to function as combined dispensing/manipulating openings. The Julius '626 patent discloses an access aperture that is "entirely" *separate* from the dispensing opening. The Julius '626 patent goes to great lengths in emphasizing that the "first opening 9" – the dispensing opening – is *separate* from the "second aperture 8." See for example lines 6 – 7 of the abstract; column 7, lines 36 to 47; and in particular column 10, lines 10, 11 (claim 1). Thus, the Julius '626 patent teaches away from configurations in which the dispensing opening and the manipulating opening are *not* separate. The Examiner cited the Julius '626 patent in combination with the Huang et al. '919 patent, which discloses a single opening which acts *both as* a manipulation opening *as well as* a dispensing opening.

#### **1. All Elements**

In contrast to the presently claimed invention, the cited prior art combination does not disclose, teach or suggest that "said manipulating opening is normally closed by a flap" as recited in the independent claims of the present application. The Julius '626 patent is silent with respect to whether the access aperture 8 is coverable; and the Huang et al. '919 patent does not disclose a manipulating opening whatsoever, let alone one that can be closed; thus the combination of cited prior art does not disclose, teach or suggest that "said manipulating opening is normally closed by a flap." As such, the presently claimed invention is not rendered obvious by the cited prior art combination for at least the reason that all of the features of the presently claimed invention are not disclosed, taught or suggested by

the cited prior art combination.

## **2. Motivation to Combine**

Furthermore, there is no motivation to combine the prior art references. Since the Julius '626 patent teaches against even joining the two openings, let alone having one opening to do both functions (insisting rather on "entirely" separate openings), there is no motivation to combine the Julius '626 patent with the Huang et al. '919 patent, which teaches a single opening.

Applicants submit that even if the two references were to be combined, the combination would not yield the present invention as claimed. If the large openings 8 of the Julius '626 patent should be closed by the slit sheet of the Huang et al. '919 patent in such a combination, then according to the Huang et al. '919 patent the slit would be used to manipulate the sheets to come out of the manipulation opening, rather than the dispensing opening, which is contrary to the Julius '626 patent disclosure – see for example column 7, lines 8 to 15.

On the other hand, it cannot be argued to simply ignore the dispensing function of the Huang et al. '919 patent, and that, in the cited prior art combination, the opening of the dispenser of the Huang et al. '919 patent would be used to manipulate the tissues to pass through the regular dispensing opening 9 of the dispenser of the Julius '626 patent. In the first place, doing so would be an improper combination of the two references as already discussed. Furthermore, the resulting combination would have 3 dispensing openings, two in the form of slits on the large openings, plus the regular dispensing opening.

Even if it is argued to use the Huang et al. '919 patent slit as a manipulation opening only, there are problems with this. The Huang et al. '919 patent slit is designed for manipulating a tissue to be drawn *out through the same opening*. If the Huang et al. '919 patent slit sheet is applied to the manipulating opening 8 of the Julius '626 patent, it would have to allow manipulation of the sheets or

tissues much further away from the slit that it was intended to do in the Huang et al. '919 patent, all the way to the dispensing slit 9. Furthermore, the Julius '626 patent states in column 8, lines 10 – 15, that the manipulating apertures 8 must be of a size to permit the user to insert his hand and to manipulate the sheet through the dispensing opening 9. Once this opening 8 is closed by the slit sheet of Huang et al. '919 patent, this would no longer be the case and the area available for inserting the fingers etc. would be much smaller, as is the intention in the Huang et al. '919 patent. Thus, unless the apertures 8 were to be greatly increased in size first and then covered by Huang et al. '919 patent slit sheet, this sheet would not allow the dispenser of the Julius '626 patent to operate as required. And then, what would be the motivation to have such a large opening 8? Thus, it is clear that there is no motivation whatsoever for combining the two references, and even if combined would not render the presently claimed invention obvious.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections to the claims.

### **Claim 13**

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over the Julius '626 patent in view of the Huang et al. '919 patent in further view of the Zaidman '298 patent.

### **Response**

By this Response, Applicants respectfully traverse the Examiner's rejections. The arguments above with respect to the Julius '626 patent and the Huang et al. '919 patent are hereby incorporated by reference.

Adding the Zaidman '298 patent to the Julius '626 patent and the Huang et al. '919 patent

combination does not cure the deficiencies of the combination. The Zaidman '298 patent discloses a dispensing cover for a container accommodating an article to be dispensed. However, the Zaidman '298 patent does not disclose, teach or suggest that "said manipulating opening is normally closed by a flap" as recited in the independent claims of the present application. Thus, addition of the Zaidman '298 patent to the cited prior art combination does not render the presently claimed invention obvious.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

### CONCLUSION

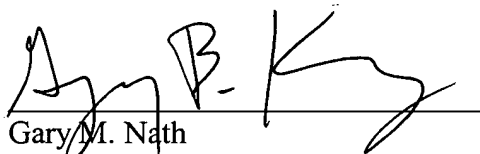
In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,  
**NATH & ASSOCIATES PLLC**

Date: January 13, 2006  
NATH & ASSOCIATES PLLC  
112 South West Street  
Alexandria, VA 22314  
(703) 548-6284

By:

  
\_\_\_\_\_  
Gary M. Nath  
Registration No. 26,965  
Gregory B. Kang  
Registration No. 45,273  
Derek Richmond  
Registration No. 45,771  
Customer No. 20529